

USSN 09/231,714
Customer No.: 006980

by providing web-page form instructions that causes a first computer to dynamically transmit an email address from a user to a second computer in response to a request for data; and processing the request at the second computer to select electronic content and e-mailing the electronic content to the email address.

REMARKS

In the Final Office Action dated 25 April 2002, by Examiner Kang in Art Unit 2152, Claims 1-23 are pending. Claims 1-19 were rejected under 35 U.S.C. § 112, second paragraph, and claims 1-23 stand rejected under 35 U.S.C. § 103(a) as obvious over Powell, 6,067,526 in view of Montulli, US Pat. No. 6,134,592. By the present Amendment and Response, Applicant has amended claims 1, 5-9, 17, and 20 to clarify the claims.

1. Rejection of claims 1-19 under 35 U.S.C. § 112, second paragraph.

Applicant has amended independent claim 1 by deleting the first instance of information, and replacing request for information with request for data to distinguish the transmitting of information from the request for data. Claims 2-19 depend on claim 1. Applicant believes this amendment addresses the Examiner's Section 112 concerns. Applicant further amended claims 5-9 and 17 to delete references to language in claim 1 that was deleted by previous amendment.

2. Rejection of claims 1-23 under 35 U.S.C. § 103

The Examiner rejected claims 1-23 as obvious over Powell, US Pat. No. 6,067,526, in light of Montulli, US Pat. No. 6,134,592. Applicant respectfully traverses this rejection, and submits that the Examiner has not established a prima facie case of obviousness. The Examiner concluded, without explanation or support, that it would have been obvious to combine the references to make the invention as presently claimed.

A prima facie case of obviousness requires three elements: (1) there must be some suggestion or motivation, in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings; (2) there must be a reasonable expectation of success found in the prior art; and (3) the references must teach or suggest all of the claim limitations. None of these three elements have been satisfied.

First, neither Powell nor Montulli, alone or in combination, suggest or motivate one of ordinary skill in the art to modify or combine the references to produce the present invention. As

USSN 09/231,714
Customer No.: 006980

discussed in the first Amendment and Response and acknowledged by the Examiner, Powell does not teach or suggest dynamically transmitting an email address in response to a request for data. Montulli teaches using "cookies" to facilitate browsing the Internet. Montulli does not teach, suggest, or motivate one to dynamically send an email address in response to a request for data. Montulli differs from the present invention in that Montulli is directed to providing World Wide Web and/or subscription information to a server to facilitate browsing the Internet.

Moreover, there is no suggestion or motivation in the knowledge generally available to one of ordinary skill in the art to combine the references. The Examiner asserts that increasing the efficiency of data transfer would be the purpose for combining the references. Applicant respectfully disagrees. Montulli teaches that a server stores information on a user's computer so that the user can easily return to a Web page etc. Thus, Montulli teaches away from the present invention because the present invention is directed in part to system and method in which an email address is dynamically transmitted to, for example, a server. The present invention does not store information sent from a server on a user's computer. Thus, Applicant submits that it would not have been obvious to a person of ordinary skill in the art to combine the references to arrive at the present invention.

Second, the Examiner does not cite any support that there would be a reasonable expectation of success found in the prior art. Indeed, neither Powell nor Montulli make any reference, explicit or implicit, to any reasonable expectation of success that a system or method that dynamically transmits an email address in response to a request for data could be obtained based on the cited references.

Third, neither Powell nor Montulli teach or suggest all of the claim limitations. In particular, neither reference teaches or suggests a system or method that dynamically transmits an email address in response to a request for data. As pointed out above, Montulli discloses a system in which a server stores information, "cookies", on a user's computer to facilitate browsing the Internet. With regard to claims 20-23, Applicant points out that these claims are directed towards dynamically sending information to a second computer, namely a server. As discussed previously, Montulli discloses a server sending information to a user's computer to facilitate web browsing. Neither Powell nor Montulli disclose or suggest dynamically transmitting an email address to for example a server in response to a request for data. Because

USSN 09/231,714

Customer No.: 006980

the cited references do not suggest or motivate one of ordinary skill in the art to modify the references or combine the references; do not demonstrate a reasonable expectation of success; and do not teach or suggest all of the claim limitations, the cited references cannot render the claims obvious, and the rejection should be withdrawn.

The present amendments clarify the invention, and Applicant submits that the amendments will not require additional searching by the Examiner.

CONCLUSION

In light of the foregoing Amendment and Remarks, Applicant believes that the now-pending Claims 1-23 are in condition for allowance. Favorable consideration and allowance of the present application is hereby courteously requested.

The Commissioner is hereby authorized to charge any deficiencies in fees or credit any overpayment to PTO Deposit Account No. 20-1507.

Respectfully submitted,

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USSN 09/231,714
Customer No.: 006980

Marked-Up Version of Amended Claims Showing Changes Made

The following is a marked-up version of the amended claims. Deleted text sections are indicated in ~~strikeout~~ and newly inserted text is underlined, and bolded.

1. (twice amended) A method of delivering electronic content, the method comprising the steps of:

providing instructions that cause a first computer to dynamically transmit information including an e-mail address to a second computer in response to a request for data information; processing the request for data ~~transmitted information~~ at the second computer; and e-mailing requested data information to the email address.

5. (once amended) The method of claim 1, wherein the instructions ~~that cause the first computer to collect information~~ comprise instructions that query the first computer for instructions.

6. (once amended) The method of claim 1, wherein the instructions ~~that cause the first computer to collect information~~ comprise instructions that receive user input.

7. (once amended) The method of claim 1, wherein the information request comprises demographic information.

8. (once amended) The method of claim 1, wherein the information request comprises system information.

9. (once amended) The method of claim 1, wherein the information request comprises executing a script.

17. (once amended) The method of claim 1, wherein ~~selecting electronic~~ processing comprises selecting electronic content based on the transmitted information.

USSN 09/231,714

Customer No.: 006980

20. (twice amended) A method of delivering electronic content, the method comprising the steps of:

providing web-page form instructions that causes a first computer to dynamically transmit ~~information including~~ an email address from a user to a second computer in response to a request for data; and

~~using the transmitted information~~ processing the request at the second computer to select electronic content and e-mailing the electronic content to the email address.